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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,778	02/22/2002	Jim Dougherty	AINNO.0110	9862
7590		09/20/2006	EXAMINER	
David W. Carstens		BASEHOAR, ADAM L		
P.O. Box 802334		ART UNIT		
Dallas, TX 75380-2334		PAPER NUMBER		
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DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/080,778	Applicant(s) DOUGHERTY, JIM	
	Examiner Adam L. Basehoar	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 06/20/06.
2. The rejection of claims 62 and 70 under 35 U.S.C. 112, second paragraph, have been withdrawn as necessitated by Amendment.
3. Claims 61-67, 69-75, and 77-79 remain rejected under 35 U.S.C. 102(e) as being anticipated by Schaefer (US-2003/0084429 05/01/03).
4. Claims 68 and 76 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer (US-2003/0084429 05/01/03).
5. Claims 61-79 are pending in this case. Claims 61, 69, and 77 are independent claims.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 61-67, 69-75, and 77-79 are rejected under 35 U.S.C. 102(e) as being anticipated by Schaefer (US-2003/0084429 05/01/03).

-In regard to independent claims 61, 69, and 77, Schaefer teaches a method for importing specifications from a product design document for use in test software, comprising:

extracting test specification data (“data for a test case”) from an electronic design document, wherein the design document was in a structured format containing both data and

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metadata (Page 4: Paragraph 53: “Alternatively, user....Microsoft Excel file”; Page 9: Paragraph 105: “In addition....in the database”);

translating the extracted test specification data into a format that was readable by the testing software (Page 9: Paragraph 105: “In addition....in the database”: i.e. test case data in an Excel spreadsheet was translated into the tables (Fig. 2: 240) stored in the database (Fig. 2: 135)); and

importing the translated test specifications into test executive software that manages testing and passes test specifications into applicable sections of underlying test library software that performs specific test functions (Page 2: Paragraph 38: “The test engine component...of the software program”; Paragraphs 54 & 55).

-In regard to dependent claims 62 and 70, Schaefer teaches wherein the test specifications include test sequence, method, and conditions (Page 1: Paragraph 10: “test case in a table structure....the software program; Page 4: Paragraphs 53 & 54: “wherein the data specifies the4 execution paths for testing”).

-In regard to dependent claims 63 and 71, Schaefer teaches assembling a variable list containing a test parameter values from said test specifications (Pages 8 & 9, Paragraphs 0102-0103: “an “X” where output data...for the test case”).

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-In regard to dependent claims 64, 72, and 78, Schaefer teaches wherein the translated test specification data was stored in a database by the testing software (Page 9: Paragraph 105: “In addition....in the database”)(Fig. 2: 135).

-In regard to dependent claims 65, 73, and 79, Schaefer teaches wherein the translated test specification data was stored in memory for immediate use by the testing software (Page 9: Paragraph 105: “In addition....in the database”)(Fig. 2: 135).

-In regard to dependent claims 66 and 74, Schaefer teaches wherein the test specifications imported into the test executive include test specification types that are pre-defined by the test software (Page 4: Paragraph 53: “Alternatively, user.....a Microsoft Excel file”; Page 9: Paragraph 105: In addition, the data.....in the database”).

-In regard to dependent claims 67 and 75, Schaefer teaches wherein the test specifications imported into the test executive include user-defined test specification types (Page 4, Paragraph 53: “User....engine component”; Page 8: Paragraph 95: “As shown in.....revising a test case.”)

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 68 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer (US-2003/0084429 05/01/03).

-In regard to dependent claims 68 and 76, Schaefer teaches monitoring the results of the testing and storing the results in a test result as well as displaying the results in a performance report (Page 4: Paragraph 55: "Test engine component.....performance reports"). Schaefer also teach wherein an imported test case could cause a failure condition and may then terminate the test (Page 9: Paragraph 108: "If test engine....if any"). Finally, Schaefer teaches wherein a user may revise a test case and save a test case (Page 8: Paragraph 95: "revising a test case").

Schaefer does not specifically teach debugging and editing the test specification with the test executive software in the event said design document contains mistakes and exporting the edited test specifications into a second, revised design document. It would have been obvious to one of ordinary skill in the art at the time of the invention for a user of Schaefer to have used the test results file and performance reports detailing the execution of the test specification data to revise the test specification document upon test failure, because Schaefer teaches that products must be tested and corrected for as many "bugs" or errors as possible before placing them in a production environment (Page 1: Paragraph 4: "Software programs....in-house use"). In this way a fully functional and error free design document could be created and utilized for further testing.

#### ***Response to Arguments***

10. Applicant's arguments filed 06/20/06 have been fully considered but they are not persuasive.

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-In regard to independent claim 61, the Applicant argues that the claimed invention is directed toward product testing within a manufacturing environment while the Schaefer reference was directed toward software testing in a software development environment. In response to applicant's argument that claimed invention is specifically directed toward product testing within a manufacturing environment, the Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Additionally, in response to applicant's arguments, the recitation, “manufacturing testing software” or “product design document”)(emphasis added), has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

-Applicant also argues that the Schaefer reference does not involve an electronic product design document from which the test specifications are drawn. The Examiner respectfully disagrees with the Applicant. Schaefer clearly teaches wherein data import utility may import test case data from a Microsoft Excel spreadsheet (Page 4: Paragraph 53: “Alternatively, user.....Microsoft Excel file”; Page 9: Paragraph 105: “In addition....in the database”). The data was then imported into one of the tables created by the GUI maps, wherein the data in the tables

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may include one or more test cases for the software program (Page 3: Paragraph 50: "The data in tables...during execution).

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB



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